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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/659,024 | 09/11/2003 | Kia Silverbrook | BAL63US | 4225 |
| 24011 | 7590 | 08/26/2004 | EXAMINER | |
| SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA | | | GARCIA, GABRIEL I | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2624 | |

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/659,024

Applicant(s)

SILVERBROOK ET AL.

Examiner

Gabriel I Garcia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 6 is/are rejected.
- 7) ☒ Claim(s) 3-5 and 7 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>9/11/03</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. Applicant should update the serial number information with respect to the cross

reference made to the U.S. application recited on page 1 of the specification.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1,2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al. (6,529,522) in view of Maeda et al. (5,493,409).

With regard to claims 1 and 6, Ito et al. teaches a handheld mobile (2) image sensing (203) and printing device (111) that comprises: a support structure (see fig. 3b); a color image sensor positioned on the support structure for sensing for sensing a color image (see figs. 4a and 4b); a color printing mechanism that is positioned on the support structure and operatively connected to the image sensor to print image sensed by the image sensor (e.g. fig. 1) , and communication between the image sensor and the printer to generate the print data (see fig. 1). Ito et al. does not disclose expressly a remote communications (radio signals, reads on the wireless communication) arrangement positioned on the support structure and operatively connected to the image sensor to transmit

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data representing the image and to receive data representing images to be printed by the printing mechanism. Ito et al. teaches that it is well known in the art to have a handheld mobile sensing device having a remote communications arrangement positioned on a support structure and operatively connected to the image sensor to transmit data representing the image (see fig. 3). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the handheld device of Maeda et al. with the communication means as taught by Ito et al. to obtain the because of the following reasons: 1) to provide the handheld device of Maeda et a. with the means to communicate information and data to an external device, and 2) to allow the handheld device of Maeda et to send the sensed images to an external device for further processing or storage by using wireless communication.

With regard to claim 2, Maeda et al. teaches the image sensor is in the form of a camera device capable of storing images on demand (reads on fig. 1).

Conclusion

4. Claims 3-5 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record does not teach or suggest the handheld device as taught by applicant's invention having the features with the details as described in claims 3-5 and 7.

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5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rossi (5,664,013) teaches an embedded notepad system for a cellular telephone.

Shepard et al. (5,107,100) teaches a portable scanner with on board keyboard, display, transceiver and printer.

Hsu (20020158135) teaches a scanning apparatus with the appearance of pen.

Torres et al. (5,749,551) teaches a portable device to allow for simultaneous duplex printing and scanning on single pass machines.

Fishbine et al. (D351144S) teaches a handheld finger print scanner for imaging and capturing a photographic image.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Gabriel I. Garcia** whose telephone number is (703) 305-8751. The examiner can normally be reached Monday-Thursday from 7:30 AM-6:00 PM. The fax phone number for official or informal faxes for this group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 306-0377.

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Gabriel I. Garcia
Primary Examiner
August 23, 2004


GABRIEL GARCIA
PRIMARY EXAMINER